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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,509	11/19/2003	Masaki Wake	034058-001	4698

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BUCHANAN INGERSOLL PC  
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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 07/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/715,509

Applicant(s)

WAKE ET AL.

Examiner

Ruth C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/19/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. In response to applicant's telephone call inquiring whether the reference being cited to reject claims 1, 2 and 4-12 under 35 U.S.C. 102(b) was the correct one as regarded by the last Office action, the following corrective action is taken.

The last Office Action is vacated.

The period for reply of 3 MONTHS set in said Office Action is restarted to begin with the mailing date of this letter.

The reference Soltysik (US 3,910,156) was not correctly cited in the last Office action as the reference being used to reject claims 1, 2 and 4-12 under 35 U.S.C. 102(b). The correct citation is also shown on the attached PTO-892.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement filed 19 November 2003 has been considered for this Office Action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 4-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Soltysik (US 3,910,156).

A spacer (10) made of metal and interposed between opposed faces of two members (13 and planar member shown in Figs. 2 and 3) having respective bores co-axial with each other and fastened to each other by inserting a fastening member (14) into the bores and tightening the fastening member (Figs. 2 and 3). The spacer comprises a base (17) and a temporarily retaining portion (11). The base is interposed between opposed faces of the members and has a through hole (16) co-axial with the bores of the respective members so that the fastening member is inserted through the hole (Figs. 2 and 3). The retaining portion is provided on an open edge of the hole of the base to temporarily retain the overall spacer on one of the members before the members are fastened to each other (Figs. 1-6). The temporarily retaining portion is inserted into the bore of the one member and caught on a wall defining the bore (Fig. 3).

The temporarily retaining portion is located at an outer peripheral side of the fastening member so as to be non-contact with fastening member (Fig. 3).

The temporarily retaining portion is flexibly bent at the open edge of the hole of the base so as to extend substantially axially and is in contact with the wall of the bore with a spring force pressing the temporarily retaining portion against the wall (Figs. 3-6).

A plurality of temporarily retaining portions is provided on the open edge of the hole of the base at regular intervals (Figs. 1-6).

The temporarily retaining portion includes a root portion and two slits formed in both widthwise ends of the root portion so as to extend from the open edge of the hole axially outward, respectively (Fig. 6).

The temporarily retaining portion has a falling-off preventing claw (tip) formed thereon by cutting a part thereof and raising the cut part, so as to be engaged with the wall of the bore of the one member (Figs. 3-6).

The temporarily retaining portion has a pair of projections (27,28) formed on respective opposite sides of a distal end thereof so that the projection extend in a circumferential direction of the hole of the base (Figs. 1-6). Each projection includes a lower edge formed to be upwardly inclined when the temporarily retaining portion is inserted into a sliding contact with the open edge of the bore of the one member so that the overall spaces is moved toward a central axis of the bore of the one member (Figs. 1-6).

Both projections can be stamped out of a base metal while lower edges of the projections are inclined from the lower edge of the temporarily retaining portion (Figs. 1-6).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Soltysik.

Soltysik discloses a spacer having all the features mentioned above for the rejection of claim 1. Soltysik fails to disclose that the spacer has a surface to which an insulating coating is applied. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply an insulating coating to a surface of the spacer disclosed by Soltysik since the Examiner takes Official Notice that insulating coating is used in application where electrical insulation is needed.

***Allowable Subject Matter***

8. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 12 and 13 are allowed.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Greenburg (US 1,400,155), Tinnerman (US 2,244,975), Johnson (US Re. 22,618 and Re. 22,544), Goldberg (US 3,226,145), McKewan (US 4,430,033), Bredal (US 4,749,318), Fisher (US 4,925,351), Ijima et al. (US 5,172,999), Bondarowicz et al. (US 6,582,171) and Hsich (US 6,811,347) are cited to show state of the art with respect to washers or spacers that have some of the features claimed by the current application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C. Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase the patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as PTO's mailroom processing and delivery time. For a complete list of correspondence **not** permitted by

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facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee that the applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to  
the Patent and Trademark Office (Fax No. (703) 872-9306) on     (Date)    .

\_\_\_\_\_  
(Typed or printed name of person signing this certificate)

\_\_\_\_\_  
(Signature)


If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ruth C. Rodriguez  
Patent Examiner  
Art Unit 3677

rcr  
July 1, 2005